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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,653	09/30/2003	Marc E. Feinberg	ETH5092 [13926]	4786
25570 7590 04/27/2011 ROBERT'S MLOTKOWSKI SAFRAN & COLE, P.C. Intellectual Property Department P.O. Box 10064 MCLEAN, VA 22102-8064				
EXAMINER RYCKMAN, MELISSA K				
ART UNIT 3773		PAPER NUMBER		
NOTIFICATION DATE 04/27/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/674,653

Applicant(s)

FEINBERG, MARC E.

Examiner

MELISSA RYCKMAN

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6, 8, 14, 21, 22 and 27-50 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 14, 21, 22, 27-37, 43-45, 49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 6, 8, 38-42, 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In view of the appeal brief filed on 7/30/10, PROSECUTION IS HEREBY REOPENED. As set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
4/21/11.

This office action is in response to claims filed 6/15/09.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Line 17 of Claim 38 states "the connector is a rotatable connector", the current specification and current drawing do not enable this, the connector as shown in the drawings, is element 139 in Fig. 7, element 139 does not rotate as it is fixed to arm.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 8, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasson (US 4724838), and further in view of Taylor et al. (US 6394951).

Regarding Claims 8 and 46, Hasson teaches a tissue approximation device comprising two elongate arms (54, Fig. 7), an attachment means (56) to secure the elongate arms to each other at one or more locations, pads (24, pad is defined in the World English Dictionary as any of various level surfaces of flat-topped structures) movably connected (move via the ball and socket (301, 302, Fig. 14) on at least a portion of the elongate arms to anchor the tissue approximation device to the tissue,

and a locking means (64) to lock the elongate arms in place relative to each other, wherein (i) the pads are spaced apart from the one or more locations of the attachment means (56) in the direction of the elongate arms (the pads 24 are spaced apart from 56 in the direction of the arms), and (ii) the tissue approximation device has an open (when moving 62 it opens and closes, Fig. 7) and a closed position, and when in the closed position, the pads are parallel and non-contiguous to each other (fig. 7, the pads are not touching when closed). The pad has a second surface that is rotatably coupled to the distal end of each of the elongate arms by a ball and socket connector (301,302, col. 5, ll. 11,12), wherein the second surface as a socket (302) and the distal end of the elongate arms has a ball (301), the pad is rotatable about the ball and socket connector about at least two axes (col. 5, ll. 15-18).

Hasson teaches the claimed invention but fails to specify the pad being an adhesive pad. However, Taylor teaches using an adhesive surface (col. 14, ll. 15-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the adhesive surface of Taylor with the pads of Hasson, as the adhesive aids in securing the device during the procedure.

Regarding Claim 5, Hasson teaches the tissue approximation device of claim 1, wherein the elongate arms (54) form a pair of forceps, the attachment means (56) is a yoke on the forceps (Fig. 7), and the locking means (64) is a ratchet mechanism on the forceps (Fig. 7).

Regarding Claim 6, Hasson teaches the tissue approximation device of claim 5, wherein the distance between the elongate arms is adjustable by means of a ratchet mechanism (64).

Regarding claim 47, Hasson teaches the claimed invention including a ball and socket connector, however does not specify the second surface has the ball and the distal end has the socket. It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the device to have the second surface have the socket and the distal end have the ball, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Regarding Claim 48, Hasson teaches the second surface and the distal end of the elongate arm connect in a snap fit manner (col. 5, ll. 11-18).

Response to Arguments

Applicant's arguments filed 7/30/10 are moot in view of the new rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RYCKMAN whose telephone number is (571)272-9969. The examiner can normally be reached on a flexible schedule, email address is melissa.ryckman@uspto.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR
/Melissa Ryckman/
Examiner, Art Unit 3773

/Darwin P. Erez/
Primary Examiner, Art Unit 3773